REMARKS

Claim Amendments

Previous claim 1 has been amended to recite that the effective amount of the antimicrobial compound inhibits the growth of *Staphylococcus aureus* as described at page 4, lines 15-16 of the specification as filed.

103(a) Rejection

Claims 1-4 were rejected under 35 USC §103(a) as being unpatentable over U.S. Patent No. 6,548,552 (US '552) in combination with U.S. Patent No. 6,313,178 (US '178). It is respectfully submitted that US '552 and US '178 cannot establish a prima facie case of obviousness. In this regard, attention is directed to M.P.E.P. § 2143.01 wherein it is stated that

> If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

Turning now to US '552, the "invention relates to an absorbent article, particularly a tampon having additives that reduce toxic shock syndrome toxin (TSST-1) production without adversely affecting a woman wearer's vaginal flora." (See column 1, lines 30-34 of US '552, underlining added). It is further stated in US '552 that the "oxygen inhibiting agent and the surface active agent can be applied in any suitable concentration (that is, an effective amount) which results in a reduction in TSS toxin production, but which does not negatively affect the wearer's normal vaginal flora." (See column 3, lines 63-67 of US '552, underlining added). Also, in US '552, it notes that "it has been found that ascorbic acid can reduce toxin production by up to about 40%, but does not inhibit

Staphylococcal growth. (See column 3, lines 35-37 of US '552, underlining added). Thus, the main purpose of US '552 is to select agents that that reduce toxic shock syndrome toxin (TSST-1) production without adversely affecting the growth of bacteria such as *Staphyloccus* species.

Now turning to US '178, it is stated that

> In another embodiment of the invention, a compound of formula (I), or a salt or pharmaceutical composition thereof, is used to inhibit bacterial cell growth. In a preferred method, the bacteria is a gram positive bacteria. In a more preferred embodiment, the gram positive bacteria is Staphylococcus aureus.

Therefore, US '178 teaches that certain lupulone derivative compounds inhibit growth of *Staphylococcus aureus*.

The Office Action is suggesting that one should substitute the compounds of US '178, which inhibit growth of *Staphylococcus aureus*, into an absorbent article that is intended to limit toxin production without adversely affect the growth of bacteria such as *Staphyloccus* species. It is respectfully submitted that this proposed modification would render the prior art invention of US '552 unsatisfactory for its intended purpose (i.e., limiting toxin production without adversely affect the growth of bacteria such as *Staphyloccus* species). Accordingly, under the guidance provided at M.P.E.P. § 2143.01 (mentioned above), the Applicants believe that the prior art does not provide suggestion or motivation to make the proposed modification. In other words, the prior art teaches away from the modification.

Conclusion

Thus, it is submitted that claims 1 to 4 are patentable over the prior art. Favorable reconsideration is respectfully requested.

A sheet is attached for the three month extension. No additional fees are believed to be needed for this amendment. However, if additional fees are needed, please charge them to Deposit Account No. 17-0055.

Respectfully submitted,

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